

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claim 10 is requested to be canceled.

Claims 6 and 11 are currently being amended.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 6-9, 11, and 27-30 are now pending in this application.

Claim Rejections - 35 U.S.C. § 112

On page 2 of the Office Action, claims 6-11 and 27-30 were again rejected under 35 U.S.C. § 112, ¶ 1, as failing to comply with the enablement requirement. In particular, it was asserted that the claims contain subject matter not described in the specification to enable one skilled in the art.

On page 3 of the Office Action, the rejection indicated that, “Applicants have argued in their response of July 31, 2006 that one of skill in the art could fill in the gaps in the specification and correct the errors. Such is not found persuasive and the rejection is repeated.” Applicants respectfully dispute this characterization of the arguments made in the previous response.

In the rejection, it was asserted that several items in the description were not clear, e.g., the structure of Figs. 3-7, the term monolithic, what elements are or are not part of other elements, and the operation and structure of the heat sink. In the Response of July 31, 2006, Applicants addressed every issue noted in the rejection. In each case, Applicants addressed each issue by explaining where and how the figures and the specification provide description sufficient to enable one skilled in the art to make and use the invention. Nowhere did the Applicants suggest that it would be necessary for one skilled in the art to fill in the gaps.

For example, with respect to forming a seal between parts 106 and 104, Applicants stated:

In particular, Figs. 3-5 plainly show how surfaces of the cover 106 facing heat sink 104 would contact surfaces on side 158 of the heat sink 104 (e.g., around the entire perimeter of side 156 of heat sink 104), and thus provide the ability to seal the cover 106 to the heat sink 104. In addition, in Fig. 3, part 106 is not flipped 180 degrees as Fig. 5 clearly shows the flow paths between the cover 106 and heat sink 104 in this orientation. The bracket shown in Figs. 3 and 5 is not essential to the structure of the device 100, as shown for example in Fig. 4, which does not include any bracket. It is also clear that the surface of cover 106 (not shown) facing side 158 of heat sink 104 is configured so that the cover 106 and the heat sink 104 can contact each other, as shown in Fig. 4. In other words, since Fig. 4 clearly shows that the cover 106 and the heat sink 104 can contact each other in the complete device 100, it is also clear that flow channels 126 and 140 (not label 158) do not interfere with this contact.

* Page 9 of Response of July 31, 2006

This explanation clearly and logically explains how a seal is formed between parts 106 and 104 and does not require or suggest that one skilled in the art would need to do anything beyond what is explicitly shown and described in the present application to make and use it.

Except for the conclusory statement in the rejection that Applicants rely on one of skill in the art to fill in the gaps in the specification and correct the errors, there is nothing in the rejection that explains where such reliance was made nor is there any reasoning as to why the explanation provided in the Response of July 31, 2006, which identifies where and how the application shows and describes the points at issue, is insufficient to satisfy the enablement requirement under 35 U.S.C. § 112, ¶ 1. In the absence of such reasoning, Applicants have no way to properly respond to this rejection beyond what was already presented in the Response of July 31, 2006.

Further, as noted in the Response of July 31, 2006, it is not clear from the rejection, what part of the claimed invention, if any, is not enabled. If the claimed invention is fully enabled, then it is not understood why a rejection under 35 U.S.C. § 112, ¶ 1, is being made. There is nothing in the current rejection that addresses this point.

Claim Rejections - 35 U.S.C. § 103

On page 3 of the Office Action, claims 6-11 and 27-30 were rejected under 35 U.S.C. § 103(a) as being unpatentable over DeHaven et al. (U.S. Patent No. 5,701,666) in view of Burward-Hoy (U.S. Patent No. 5,977,785).

Claim 6, as amended to incorporate the recitation of canceled claim 10, recites that a testing system for electronic devices comprises a plurality of active temperature control devices for regulating the temperature of at least one device under test (“DUT”), each of the active temperature control devices comprising a thermal transfer surface configured to establish a thermal path to a respective DUT, a fluid-cooled heat sink thermally coupled to the thermal transfer surface, the fluid-cooled heat sink being configured to maintain a flow of coolant proximate the thermal transfer surface, and a heater configured to heat the respective thermal transfer surface. Claim 6 further recites that the testing system comprises a coolant flow control system coupled to the active temperature control devices, the coolant flow control system being configured to individually regulate the flow rate of coolant through each fluid-cooled heat sink.

In the rejection it is admitted that DeHaven does not disclose or suggest a fluid-cooled heat sink, and relies on Burward-Hoy to cure this deficiency. In the rejection of claim 10, reference is made to column 3, lines 17+, of Burward-Hoy to allegedly provide a teaching of the active temperature control device having a resistive heater. The applicable disclosure is as follows:

The advantage of being able to vary the temperature of the DUT during testing can also be provided by substituting the heat exchanger with another type of heat transfer device. For example, a resistive reactive heater may be coupled to the plate to vary the temperature of the surface area of the plate. Heat exchangers and other fluid-based heat transfer systems typically provide the ability to change temperatures more quickly than reactive heating devices. Another alternative embodiment couples an inductive heater to the plate or directly to the DUT.

* Column 3, lines 17-26 of Burward-Hoy

This disclosure makes clear that controlling the temperature of the DUT during testing can be provided by the heat exchanger OR by a resistive reactive heater. Specifically, Burward-Hoy says that the temperature control “can be provided by substituting the heat

exchanger with another type of heat transfer device,” such as a resistive reactive heater or an inductive heater. Thus, Burward-Hoy fails to disclose or suggest that the active temperature control device would include BOTH a heat exchanger AND a heater. Rather, it only suggests one or the other.

Since DeHaven admittedly fails to disclose or suggest a heat exchanger, both DeHaven and Burward Hoy fail to disclose or suggest that the active temperature control device would include BOTH a heat exchanger AND a heater. Accordingly, even if combinable, claim 6 is patentably distinguishable from the combination of DeHaven and Burward-Hoy.

Claims 7-11 and 27-30 are also patentably distinguishable from the combination of Burward-Hoy and DeHaven et al. by virtue of their dependence from claim 6, as well as their additional recitations.

Applicants also reiterate, as set forth in the Amendment of January 11, 2006, that claims 7-9 and 11 were asserted to be inherent from the combination of DeHaven and Burward-Hoy. As in the prior Office Action, the PTO has failed to provide a rationale or evidence tending to show inherency. “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Because the PTO failed to provide evidence that the limitations are necessarily present in the combination, reconsideration and withdrawal of the rejection is respectfully requested.

Therefore, for these reasons, reconsideration and withdrawal of the rejection of claims 6-11 and 27-30 is respectfully requested.

Applicants submit that entry of this Amendment is proper because the amendment to claim 6 merely incorporates the recitations of a canceled dependent claim, and thus should not require further search and/or consideration.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. § 1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By  _____

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